

## REMARKS

Claims 1-10, 19-54 and 65 are pending in the application and stand rejected. Claims 1, 19, 27, 37, 44, 47-49 and 65 have been amended. In view of these amendments and the following remarks, Applicant respectfully submits that all pending claims stand in condition for allowance.

**Rejection of claims 1-7, 9-10, 19-23, 25-34, 36-40, 42-51, 53-54 and 65 under 35 U.S.C. § 103(a) as being unpatentable over Crosby in view of Jackson**

**Claim 1**

Claim 1, as amended, recites receiving a radio broadcast at a vehicle, wirelessly transmitting content from a server to the vehicle via a data network based on radio broadcast information associated with the received radio broadcast, automatically presenting the content over a user interface at the vehicle, and, after receiving the radio broadcast and transmitting the content, recording at least one request made by a user based on the presented content, wherein the recording of the request is not required to receive the broadcast.

For example, referring, *e.g.*, to FIGURES 1-2 and paragraphs 20-22 of the application, a main system 22 generates interactive content for use by the user at the vehicle. The interactive content can include a wide variety of information including, for example, product information. Using telematic control unit 26, the user can select from the offered content (products or services) directly related to broadcast radio content. The interactive content is related to broadcast radio content and the specific circumstances of the user. Main system 22 obtains information related to the broadcast radio content, such as broadcast time schedule, from the business system. The main system determines what interactive content to send based on the radio station the motorist is listening to, and where to send the interactive content based on the

vehicle's location. This information is obtained from the vehicle's telematic control unit. The resulting system provides the user with a variety of options with respect to making purchases based on the interactive content presented over the radio. When a motorist or passenger makes a selection related to the presented interactive content, wireless communication module 34 sends a request in the form of a message to process a transaction to wireless gateway 14, such as a request to purchase an item.

As acknowledged by the Examiner, Crosby fails to teach or suggest recording, after transmitting the content, any requests made by the user based on the presented content. The Examiner cites Jackson as providing the teachings omitted in Crosby. The Applicant respectfully traverses this contention.

Jackson, at, *e.g.*, FIGS. 1-3 and col. 3, line 54 to col. 4, line 13, teaches that a user would have a portable digital cellular device 34 installed in their automobile and coupled to their automobile radio or stereo system. Alternatively, the portable digital cellular device 34 could be designed to be part of the automobile radio or stereo system. A user would view a liquid crystal display window 46 and make a musical selection by speaking the title of the song desired. Voice recognition selection circuit 48 would then signal the microwave cellular transmitter/receiver 36 to transmit a signal to the microwave cellular tower 12 indicating the desired song. The microwave cellular transmitter/receiver 22 of microwave cellular tower 12 would receive the signal and send it to the selection processor 24. The selection processor 24 would bill a user's account and retrieve the desired musical selection via data bus lines 26 and control bus lines 28 from storage unit 30. The selection processor would then transmit the retrieved musical selection to microwave cellular transmitter/receiver 22 for transmission (what the Examiner apparently analogizes to a radio broadcast) to the portable digital cellular device 34. The portable digital cellular device 34 would receive the transmission through its microwave cellular transmitter/receiver 36. The signal would then be processed by selection processor 38 that would store the song on solid state memory chips 44. The user could then play the song immediately or

leave it in solid state memory chips 44 for playback later. Thus, in the Jackson reference, the recording of a request is a pre-condition of receiving the song.

As such, and as asserted by Applicants in an earlier paper, because a) the teachings of Jackson require the user to make a request before receiving the song/broadcast, and b) Crosby expressly requires that user feedback/request is received only after broadcast content has already been received (*see, e.g.*, Abstract of Crosby), the combination of the teachings of Jackson with that of Crosby would render both the Jackson and Crosby systems non-functional.

While the Examiner correctly states that the test for obviousness is what the combined teachings of the references would have suggested to those of ordinary skill in the art, the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *See, e.g., In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990); MPEP §2143.01(III). If the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose (as is clearly the result of combining the Jackson and Crosby references), then there is no suggestion or motivation to make the proposed modification. *See, e.g., In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984); MPEP §2143.01(V). Moreover, if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified (as is also clearly the result of combining the Jackson and Crosby references), then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *See, e.g., In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959); MPEP §2143.01(VI).

Accordingly, the Applicant's attorney respectfully submits that it cannot be reasonably argued that the Applicant's invention as recited in claim 1 is obvious in view of these references.

**Claims 19, 27, 37, 44, 47-49 and 65**

Claims 19, 27, 37, 44, 47-49 and 65 are patentable for at least reasons similar to those discussed above with reference to claim 1.

**Claims 2-7, 9-10, 20-23, 25-26, 28-34, 36, 38-40, 42-43, 45-46, 50-51 and 53-54**

Claims 2-7, 9-10, 20-23, 25-26, 28-34, 36, 38-40, 42-43, 45-46, 50-51 and 53-54 are patentable by virtue of their respective dependencies from claims 1, 19, 27, 37, 44 and 49.

**Rejection of Claims 8, 24, 35, 41 and 52 Under 35 U.S.C. 103(a) as being  
unpatentable over Crosby, Jackson and Treyz**

Treyz fails to supply the teachings missing from Crosby and Jackson, namely receiving a radio broadcast at a vehicle, wirelessly transmitting content from a server to the vehicle via a data network based on radio broadcast information associated with the received radio broadcast, automatically presenting the content over a user interface at the vehicle, and, after receiving the radio broadcast and transmitting the content, recording at least one request made by a user based on the presented content. As such, Crosby, Jackson and Treyz, taken either each alone or in combination, fail to teach the limitations of claims 1, 19, 27, 37 and 49. Accordingly, claims 8, 24, 35, 41 and 52 are patentable by virtue of their respective dependencies from claims 1, 19, 27, 37 and 49.

### CONCLUSION

In view of the above amendments and remarks, Applicant requests entry of the amendments and a finding of allowability for all pending claims. If the Examiner has any questions, or desires that an interview be conducted, the Examiner may contact the Applicants' attorney below. **If the Examiner disagrees with the Applicants' position as stated herein, the Examiner is respectfully requested to contact the undersigned to arrange a telephonic discussion of the application prior to issuing an Office Action rejecting any of the claims in view of the references discussed herein.**

Respectfully submitted,

BLACK LOWE & GRAHAM<sup>PLLC</sup>



P. G. Scott Born  
Registration No. 40,523  
Direct Dial: 206.957.2491